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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,164	12/22/2003	Edward J. Rupnick	EJR-003	7747

7590
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11/16/2005

EXAMINER

WILLIAMS, JAMILA O

ART UNIT PAPER NUMBER

3722

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/743,164	Applicant(s) RUPNICK, EDWARD J.	
	Examiner Jamila O. Williams	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-25,35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-25,35 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-17, 19, 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 19 the preamble suggest that the applicant is intending to having a “closed” type claim (indicated by the use of “consisting of”), however in the body of the claim the applicant uses “comprising” which is associated with “open-ended” claims. This causes some uncertainty about the scope of the claim. In claim 15 (which depends from 36), it is unclear if the anchoring means is the same as the first and second anchors recited in claim 36 or if another structure is being recited. A similar issue exist with claim 17 (a plurality of anchoring means).

In claim 23, there is a lack of antecedent basis for “a second one of the passages”. Claim 24 is also indefinite since it depends from rejected claim 23.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13,14, 21-22,35,36 are rejected under 35 U.S.C. 102(b) as being anticipated by 3,425,421 to Feder. Feder discloses a substantially narrow and rigid elongated support bar (cover), a compacting means (folding hinge 9), a single resilient elastic retainer (spring steel wire) being structured to extend between two spaced apart edges of the support bar and having first and second anchors provided adjacent respective first and second ends thereof (fig 5 and 2). Feder further discloses that the support member is formed of plastic (col 2 lines 35-37) and having a rectangular shape (fig 4). Feder discloses anchors on the first and second end of the retainer (fig 5) and the support bar comprising a passage formed as a slot (fig 2) communicating with the first edge portion of the support bar adjacent the first end thereof. One of the anchors being a hook (fig 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-21,25,35-36, are rejected under 35 U.S.C. 103(a) as being unpatentable over 6,045,159 to Bellah in view of 2,808,908 to Lykes (cited in a previous action). Bellah discloses a book page holder consisting of a

substantially narrow and rigid elongated support bar (backing 12, spring assembly 14 and cover 16 make up the support bar), the support bar being formed with two opposing edges spaced apart across a width, the support bar further comprising means for compacting the support bar (col. 2 lines 57-60). Bellah also discloses having a single retainer (18) that is structured to extend between two spaced apart edges of the support bar and having first and second anchors structured to secure the first and second ends of the retainer to spaced apart edges of the support bar (stitch 44 holds the first end and tabs 54 or 56 releasably hold the opposing end). Bellah does not however disclose that the retainer is resilient and elastic, as recited in claims 19-20.

Lykes discloses having a resilient and elastic retainer (elastic cord 5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the material of the retainer of Lykes with the retainer of Bellah for the purpose of providing a more durable retainer.

Bellah discloses the claimed invention as recited above except for having bookmaker 60. It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit this element since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over 6,045,159 to Bellah in view of 2,808,908 to Lykes and further in view of

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6,453,589 to Schwartz (cited in a previous action). Bellah (and the material modification of Lykes) discloses all of the elements of the claims but for the slippery contact surface. Schwartz teaches using a retaining means that is fabric covered (column 4 lines 41-42). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the fabric covered elastic material teaching of Schwartz with the retaining means of Bellah for the purpose of providing a more durable retainer. Thus providing the elastic material with a slippery contact surface, as recited in claim 15. Claims 16-17 are also rejected as best understood (see 112 rejection above).

Claims 10,11,12,14,21-24,35 are rejected under 35 U.S.C. 103 (a) as being unpatentable over 2,807,908 to Lykes in view of 5,722,691 to Patel. See rejection in office action mailed 7-28-05.

Claim 18 and 36 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Lykes in view of Patel and further in view of 4,462,614 to Krause. See rejection in office action mailed 7-28-05.

Claims 15-17 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Lykes in view of Patel and further in view Schwartz. See rejection in office action mailed 7-28-2005.

Response to Arguments

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Arguments filed with RCE 10/28/2005 are moot in view of new grounds of rejection. It is noted that applicant has added claims using "consisting essentially of" language. For the purposes of searching and applying art under 35 U.S.C 102/103 absent any clear indications in the specification or claims what the basic and novel characteristics actually are, "consisting essentially of" will be construed as being equivalent to "comprising. See MPEP 2111.03. As such the examiner has rejected claims 35-36 with new art and copied some of the rejections relied upon in a previous rejection (final mailed 7-28-2005).

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O. Williams whose telephone number is 571-272-4431. The examiner can normally be reached on Mon-Fri 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 11/12/05
JW


BOYER D. ASHLEY
PRIMARY EXAMINER